

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

BLACKBERRY LIMITED,
Patent Owner.

IPR2019-00938 (Patent 8,209,634 B2)
IPR2019-00939 (Patent 8,209,634 B2)

Before MIRIAM L. QUINN, GREGG I. ANDERSON, and ROBERT L. KINDER,
Administrative Patent Judges.

QUINN, *Administrative Patent Judge.*

ORDER TO SHOW CAUSE
Conduct of the Proceeding
37 C.F.R. §§ 42.5(a), 42.71(a), 35 U.S.C. §§ 314(a), 325(d)

IPR2019-00938 (Patent 8,209,634 B2)

IPR2019-00939 (Patent 8,209,634 B2)

Petitioner filed each of the Petitions in the captioned cases on April 5, 2019. Petitioner asserts that these petitions are “a substantive copy of one Facebook’s ’634 petitions.” *See* IPR2019-00938, Paper 2, 2; IPR2019-00939, Paper 2, 1 (hereinafter referred to as “Snap’s petitions”). This statement alludes to the fact that a day earlier (April 4, 2019) another Petitioner (e.g., Facebook, Inc. et al.) filed two petitions addressing Patent No. 8,209,634 B2 (“the ’634 patent”). *See* IPR2019-00924 (copied in IPR2019-00939), and IPR2019-00925 (copied in IPR2019-00938) (hereinafter referred to as “Facebook’s petitions”). Consequently, there are four (4) pending petitions addressing the same claims of the ’634 patent, two filed by Snap (Petitioner here), which are copies of the two petitions filed by Facebook, among other entities. Snap’s petitions are substantively identical to Facebook’s petitions, yet there is no Motion for Joinder or any other paper addressing the duplicative nature of these filings.

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Our discretionary determination of whether to institute review takes into consideration guidance in the Office Patent Trial Practice Guide, 2018 Update, 83 Fed. Reg. 39,989 (August 13, 2018) (“2018 Trial Practice Guide Update”), <https://go.usa.gov/xU7GP>. In particular, the Trial Practice Guide Update states

IPR2019-00938 (Patent 8,209,634 B2)

IPR2019-00939 (Patent 8,209,634 B2)

[t]here may be other reasons besides the “follow-on” petition context where the “effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,” 35 U.S.C. § 316(b), favors denying a petition even though some claims meet the threshold standards for institution under 35 U.S.C. §§ 314(a), 324(a).

2018 Trial Practice Guide Update 10–11. We also construe our rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310, slip op. at 42 (PTAB Jan. 24, 2019) (Paper 7) (informative).

More recently, the Board issued additional guidance concerning parallel petitions challenging the same patent. *See* 84 Fed. Reg. 33,925 (July 16, 2019) (available at <https://www.uspto.gov/TrialPracticeGuide3>) (“2019 Trial Practice Guide Update”). The guidance states that “one petition should be sufficient to challenge the claims of a patent in most situations.” *Id.* at 26. Furthermore, “if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions identify” an enumerated ranking of the petitions and an explanation of the differences, including why the differences are material. *Id.* at 27. In particular, the Board requests that petitioner explain “why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” *Id.*

Here, Petitioner not only has filed two petitions challenging the same claims of the ’634 patent, but these two Snap petitions are also substantively identical to the Facebook petitions. The inefficient use of Board resources is evident. If one of Facebook’s petition is granted, absent other reasons for denial of the correspondingly identical Snap petition, the result would be two independent trials,

IPR2019-00938 (Patent 8,209,634 B2)

IPR2019-00939 (Patent 8,209,634 B2)

each with its own set of briefs and supporting evidence, and both challenging the same claims, under the same grounds. The potential for inconsistency across the two proceedings is also evident. Finally, consolidation of cases under 35 U.S.C. § 315(d) would not alleviate these concerns. And finally, we note that under § 325(d), the Director may reject the petition “because the same or substantially the same prior art or arguments previously were presented to the Office.”

The 2019 Trial Practice Guide Update allows for briefing on the matters of discretionary denial when it pertains to parallel petitions challenging the same patent. Here, we authorize such briefing in connection with this Order to Show Cause. In particular, the panel issues this Order for Petitioner (Snap, Inc.) to show why we should not dismiss Snap’s petitions as duplicative and an inefficient use of the Board’s resources. Alternatively, and to remedy the inefficiencies brought on by these identical petitions, Petitioner may file a motion for joinder in lieu of the brief authorized by this Order. Patent Owner will also have the opportunity to file a responsive brief to Petitioner’s brief or, alternatively, a motion for joinder.

It is therefore ORDERED, that Petitioner file a brief showing cause why the Petitions in the captioned proceedings should not be dismissed under 35 U.S.C. §§ 314(a) and 325(d) if Petitioner elects not to file a motion for joinder with the corresponding identical Facebook petition. The brief should not exceed three (3) pages and is due within 5 business days from entry of this Order. A motion for joinder, as stated above, may be filed in lieu of the brief.

It is FURTHER ORDERED that Patent Owner is authorized to file a response brief to either Petitioner’s brief or motion for joinder. Patent Owner’s brief should not exceed three (3) pages and is due within 5 business days from Petitioner’s filing. An opposition to the motion for joinder, if Petitioner elects to

IPR2019-00938 (Patent 8,209,634 B2)

IPR2019-00939 (Patent 8,209,634 B2)

file one in lieu of a brief, is authorized and is due also 5 days from the filing of the motion.

It is FURTHER ORDERED that no other briefs or motions are authorized.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.